

REMARKS

Claims 1-3, 5-8, 10-15, 17-21 and 23-27 are pending in the present application. Claims 1, 6, 11, 12, 13, 19 and 25-27 have been amended and claims 4, 9, 16 and 22 have been cancelled as a result of this Response. Claims 1, 6, 11, 12, 13, 19 and 25-27 are independent claims.

ART REJECTIONS

Claims 1-3, 5-8, 10, 12, 13-21, and 23-27 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Moghadam et al in view of Cameron et al. and PC Magazine online. Further, claims 4, 9, 16, and 22 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Moghadam in view of Cameron, PC Magazine Online and U.S. Patent 5, 229,810 to Cloutier, et al.; claims 11 and 13-15 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Moghadam in view of PC Magazine Online; and claim 12 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Moghadam et al in view of PC Magazine Online, and Cloutier et al. These rejections, in so far as they pertain to the presently pending claims, are respectfully traversed for the following reasons.

In applicant's prior response of December 8, 1999, applicants argued that the Examiner has failed to establish motivation why one of ordinary skill in the art would combine Moghadam et al, Cameron et al. and PC Magazine Online.

In the outstanding Office Action, the Examiner relies on an additional references, namely U.S. patent No. 5,229,810 to Cloutier et al. However, applicant's respectfully submit that the Examiner has failed to establish motivation for why one of ordinary skill in the art would combine Cloutier et al. with the Moghadam/Cameron/PC Magazine Online combination. On page 17 of the Office Action, the Examiner asserts:

"It would have been obvious to include this additional information with the printing service information disclosed in Moghadam. The motivation would have been to allow customers to feel much more comfortable placing orders by providing them with information as to would be performing the services on their photographs."

However, applicants respectfully submit that the Examiner has failed to establish any basis for this motivation. There must be some explicit teaching or suggestion in the art to motivate one of even ordinary skill to combine elements so as to create the same invention. Arkie Lures, Inc. v. Gene Larew Tackle, Inc. 43 USPQ 2d 1294, (Fed. Cir. 1997). Similar to the facts in Arkie Lures, nothing in Moghadam, Cameron, the PC Magazine Online, or Cloutier suggests the combination put forth by the Examiner. The Examiner's alleged motivation set forth on page 7 can be found nowhere in any of the references relied upon by the Examiner. Applicant's respectfully submit that the subject matter of dependent claims 4, 9, 16 and 22 has been added to each of independent claims 1, 6, 11, 12, 13, 19, and 25-27. Accordingly, applicants

respectfully submit that these independent claims are allowable over the prior art of record.

Applicants further respectfully submit that dependent claims 2-3, 5, 7-8, 10, 14-15, 17-18, 20-21, and 23-24 are allowable by virtue of their dependency on allowable independent claims 1, 6, 13 or 19 for at least the reasons set forth above.

CONCLUSION

In view of the above amendments and remarks, reconsideration of the various rejections and allowance of claims 1-3, 5-8, 10-15, 17-21 and 23-27 of the present application is respectfully requested.

The amendments presented in the response are for the purpose of placing the application in better form for U.S. practice with the exception of the amended feature emphasized above in the traversal of the art rejections.

In the event that there are any outstanding matters remaining in the present application, the Examiner is invited to contact John A. Castellano at (703) 205-8000 in the Washington, D.C. area, to discuss this application.

Pursuant to 37 C.F.R. §§ 1.17 and 1.36(a), Applicants respectfully petition for a one (1) month extension of time for filing an Amendment in the present application. Please charge the required fee of **\$110.00** to Deposit Account No. 02-2448 for a one (1) month extension of time to September 10, 1999.

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If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. 1.16 or under 37 C.F.R. 1.17; particularly, extension of time fees.

Respectfully submitted,

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